1642

PATENT

Case Docket No. GENENT.061CP2
Date: June 7, 2002
Page 1

In re application of	:	Lasky et al.
App. No.	:	09/068,377
Filed	:	May 8, 1998
For	:	TYROSINE PHOSPHORYLATED CLEAVAGE FURROW-ASSOCIATED PROTEINS (PSTPIPs)
Examiner	:	S. Rawlings
Art Unit	:	1642

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June 7, 2002
(Date)

Ginger R. Dreger, Reg. No. 33,055

UNITED STATES PATENT AND TRADEMARK OFFICE
Arlington, VA 22202

Sir:

Transmitted herewith is a response in the above-identified application.

The fee has been calculated as shown below:

CLAIMS AS FILED

	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDITIONAL FEE
Total Claims	4	—	23	= 0 ×	$18	= $0
Independent Claims	1	—	3	= 0 ×	$84	= $0
If application has been amended to contain multiple dependent claim(s), then add					$280	= $N/A
Time Extension Fee						$0
				TOTAL ADDITIONAL FEE FOR THIS AMENDMENT		**$0**

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GENENT.061CP2 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Lasky et al.	Group Art Unit: 1642
Appl. No.	:	09/068,377	
Filed	:	May 8, 1998	
For	:	TYROSINE PHOSPHORYLATED CLEAVAGE FURROW-ASSOCIATED PROTEINS (PSTPIPs)	
Examiner	:	S. Rawlings	

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June 7, 2002
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Ginger R. Dreger, Reg. No. 33,055

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RESPONSE

United States Patent and Trademark Office
P.O. Box 2327
Arlington, VA 22202

Dear Sir:

This response is filed in reply to the Examiner's communication, Paper No. 31, mailed May 9, 2002, stating that Applicant's previous reply, Paper No. 29, filed February 21, 2002, was not fully responsive to the prior Office Action, Paper No. 28, mailed November 21, 2001. Specifically, the Examiner found that Applicants did not respond to the rejection of claims 15-18 under 35 USC § 103(a) as being unpatentable over Marra, et al in view of Ackerman." (Paper No. 31, page 2.)

Applicants prior response (Paper No. 29) canceled claims 15 and 23, added new claim 24, and amended claims 16-18. Claims 16-18 and new claim 24 are currently under prosecution.

Rejection of claims 15-18 under 35 U.S.C. § 103(a)

The Examiner rejected claims 15-18 under 35 U.S.C. § 103(a) as being unpatentable over Database GenBank Accession No. AI322422 (Marra et al., 1996), in view of Ackerman (Human

Cell 1:46-53, 1998). Applicants submit that this rejection is overcome by the amendments set forth in Paper No. 29, filed February 21, 2002, and by the arguments below.

In making the rejection, the Examiner found that because the nucleic acid molecule taught by Mara would hybridize to a portion of the nucleic acid molecule of SEQ ID NO: 2, "the nucleic acid molecule of the prior art is deemed the same as the nucleic acid molecule of the claims." In Paper No. 29, Applicants canceled claim 15 and added new claim 24, which recites "[a]n antibody that binds to the PST phosphatase interaction protein (PSTPIP) polypeptide of SEQ ID NO:1 at a site . . . within said SEQ ID NO:1." Applicants respectfully submit that as new claim 24 does not recite a nucleic acid molecule, the nucleic acid molecule taught by Marra can not be "the same as the nucleic acid molecule of the claim."

Based on the finding that the nucleic acid molecule of Marra would hybridize to SEQ ID NO: 2, the Examiner concluded that "the antibodies that bind the protein encoded by the nucleic acid molecule of the prior art are deemed the same as the antibodies of the claims." However, while Marra teaches a cDNA fragment, Marra does not teach or suggest a polypeptide encoded by the disclosed nucleic acid molecule. More specifically, Marra does not provide a polypeptide sequence or teach an open reading frame encoding a protein. As a result, Marra does not teach or suggest the full length PSTPIP of SEQ ID NO:1, or even a fragment thereof and thus fails to teach or suggest all the limitations of new independent claim 24.

Further, because Marra fails to teach or suggest a polypeptide, Marra also fails to teach or suggest antibodies directed against the protein. Indeed, it is the Applicants' own disclosure that teaches the PST phosphatase interaction protein (PSTPIP) of SEQ ID NO:1, thus providing the suggestion and motivation for making and using the claimed antibody against a site within SEQ ID NO:1. The hybridoma methodology taught by Ackerman fails to cure the deficiencies of Marra because it does not teach or suggest a polypeptide sequence corresponding to the nucleic acid sequence of Marra.

In view of the foregoing arguments, Applicants submit that new claim 24 and dependent claims 16-18 are patentable over Marra in view of Ackerman. Applicants have canceled claim 15, and the Examiner's rejection is therefore moot as to this claim. Withdrawal of the rejection of claims 15-18 under 35 U.S.C. § 103(a) is respectfully requested.

Conclusion

As Applicants have fully responded to the prior Office Action, Paper No. 28, Applicants submit that pending claims 16-18 and 24 are in condition for allowance, and early notice to that effect is earnestly solicited. If any issues remain or require further clarification, the Examiner is respectfully requested to call Applicants' counsel at the number listed below to resolve such issues promptly.

Applicants believe that no fee is due with this communication. However, if the U.S.P.T.O. determines that a fee is due, please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: June 7, 2002

By: _____

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